

REMARKS

Present Status of Application

The Examiner is thanked for the thorough examination of the present application and the indication that claims 6 and 11 contain allowable subject matter. Claims 7 and 12 are canceled. Claims 1-5 and 8-10 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Applicant's Admitted Prior of Figures 1-3 in view of Huang et al (PN 6,762,466). Reconsideration of this application is respectfully requested in light of the amendments herein and the remarks set forth below.

Amendments to claims

Independent claims 1 and 8 have been amended to more clearly identify the relation between the conductive structure and the wire bonding portion. Support for the added limitation: "a conductive structure surrounding the wire bonding portion" in amended claims 1 and 8 can be found in at least Fig.5A and 5B. Accordingly, the amendment adds no new matter to this application.

Rejections under 35 U.S.C. 103(a)

Applicant respectfully traverses the rejections for at least the reasons discussed below. Amended claims 1 and 8 recite: "a conductive structure surrounding the wire bonding portion, connecting the first edge portion and the second edge portion." As embodiment of this structure is illustrated in Fig.5A and 5B of the application. Accordingly, the claims require, among other features, a wire bonding portion surrounded by a conductive structure which connects the edge portions of a upper conductive layer and a lower conductive layer. For example, as shown in

Fig.4 and 5A, the second plugs 424 connect the first metal layer 410 and the second metal layer 430, and surround the wire bonding region 452.

Applicant respectfully submits that the cited art does not teach or suggest such a conductive surround a wire bonding portion. As stated by the Office Action, Applicant's Admitted Prior Art of figures 1-3 do not disclose a conductive structure connecting the first edge portion and the second edge portion. In contrast, and according to Figs 3-4 of Huang et al, although the reference discloses a via 224 connecting the edge portions of a first conductive layer 204 and a second conductive layer 208 through conductive lines 222 and 226 respectively, it still fails to teach or suggest a conductive structure surround a wire bonding portion. Indeed, Huang et al only teach that the connecting via 224 is disposed outside the conductive layer and electrically connects the conductive layers by conductive lines 222 and 226. For at least this reason, amended claims 1 and 8 patently define over the cited art.

As none of the cited references, when taken alone or in combination, teaches or suggests the feature as set forth in amended claim 1 and 8, amended claims 1 and 8 are allowable over the cited references. Insofar as claims 2-5 and claims 9-10 depend from claim 1 and claim 8, these claims are also allowable at least by virtue of their dependency.

As a separate and independent basis for the patentability of claims 1-5 and 8-10 (and therefore all claims), Applicant respectfully submits that the Office Action has failed to cite a proper motivation or suggestion for combining the various references. In rejecting independent claims 1 and 8, the Office Action alleged that the combination of Huang with Applicant's admitted prior art would have been obvious "in order to discharge a layer current through multiple paths and to improve the circuit protection capacity." (Office Action, p. 3) This alleged

motivation clearly fails to comply with well-established Federal Circuit precedent for rejections under 35 U.S.C. § 103(a).

It is well-settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(*Emphasis added.*) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. Stiftung v. Renishaw PLC, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to derive a glass molding die, as claimed by the Applicant.

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also

noting that the “absence of such a suggestion to combine is dispositive in an obviousness determination”).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be “clear and particular.” Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

If there was no motivation or suggestion to combine selective teachings from multiple prior art references, one of ordinary skill in the art would not have viewed the present invention as obvious. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); Gambro Lundia AB, 110 F.3d at 1579, 42 USPQ2d at 1383 (“The absence of such a suggestion to combine is dispositive in an obviousness determination.”).

Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. Winner Int'l Royalty Corp. v. Wang, No 98-1553 (Fed. Cir. January 27, 2000).

For at least this additional reason that the Office Action failed to identify proper motivations or suggestions for combining the various references to properly support the rejections under 35 U.S.C. § 103, the rejection of claims 1-5 and 8-10 should be withdrawn.

New claim 24-28

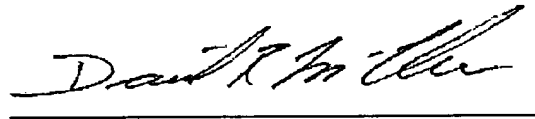
New independent claim 24 (and dependent claims 25-28) define features that are neither disclose nor suggested in the prior art of record. Therefore, these claims are allowable.

All pending claims are believed to be in condition for allowance, and the Examiner is respectfully requested to pass those claims to issuance. If the Examiner believes a teleconference will expedite the examination of this application, the Examiner is invited to contact the undersigned attorney at 770-933-9500.

No fee is believed to be due in connection with this Amendment and Response to Restriction Requirement. If, however, any fee is deemed to be payable, you are hereby authorized to charge any such fee to deposit account 20-0778.

Respectfully submitted,

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